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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,423	08/20/2003	David M. Kwasny	200207936-1	6967
22879	7590	06/01/2005		
			EXAMINER	
			PHAM, HAI CHI	
			ART UNIT	PAPER NUMBER
			2861	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PA

Office Action Summary	Application No.	Applicant(s)	
	10/644,423	KWASNY ET AL.	
	Examiner	Art Unit	
	Hai C. Pham	2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16, 18-21 and 23-34 is/are rejected.
- 7) Claim(s) 17 and 22 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/20/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 34 is objected to because of the following informalities:
 - Line 4, "mechanisms that is" should read --mechanisms that are--.Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2, 8-10, 18, 23-29, 31-32, 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Morishima (Pub. No. U.S. 2004/0037176).

Morishima discloses a method for writing image data on the label side of the optical disc comprising receiving image data from a host computer to be written along circumferential zones defined on a coloring layer of the label face (paragraph [0137]), and formatting the information/image data so that the information is optically written on a least number of tracks on the label face so as to minimize the optical writing time of the information (not only the number of gradation data of the information being reduced to reduce the time for writing the information data on the label face, but also the writing head is allowed to skip track when the gradation data is of a certain value) (paragraphs [0192] and [0210]).

Morishima further teaches:

- (referring to claim 2) optically writing the information data onto the optically writable label side (e.g., label face) of the optical disc,
- (referring to claims 8-10) optically writing the information data onto the upper optically writable label side of the optical disc (Figs. 4-5),
- (referring to claim 18) selected data being recorded on the optically writable data side opposite to the optically writable label side of the optical disc (Fig. 4).
- (referring to claims 23, 26-29, 31-32) a computer program or a controller to format the information data (a program stored in a machine readable medium and executed by the CPU) (paragraph [0107]),
- (referring to claim 24) a host computing device (Fig. 1),

- (referring to claim 25) display device so that an end user is able to approved formatting of the information (the display device being inherent since the user is able to make a decision with regard to the gradation data (paragraph [0117])),
- (referring to claim 34) a plurality of motor mechanisms that are able to rotate the optical disc (e.g., spindle motor 130) and to move the optical marking mechanism (e.g., stepping motor 140) radially relative to the optical disc (Fig. 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-7, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishima in view of Onodera et al. (Pub. No. U.S. 2001/0040867).

Morishima discloses all the basic limitations of the claimed invention except for the information data to be written onto the label side being extracted from data previously written on the optically writable data side, which data including artist/album name, song name, title name, and/or date.

Onodera et al. discloses an information recording apparatus and method for writing information data on the label side of the optical disc, wherein the information data is being extracted from pre-recorded area of the data side, e.g., TOC, UTOC

included in the reproduced data) (paragraphs [0052], [0057], [0064]), and wherein the information data includes data such as album titles, names of music pieces, artist names, and date (paragraph [0118]) (Figs. 1, 9).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the pre-recorded data related to the information data embedded in the recording data side in the device of Morishima as taught by Onodera et al. the motivation for doing so would have been to produce accurate visual indicator of the content of the data side on the label face of the optical disc.

6. Claims 15-16, 19-21, 30, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishima in view of Pettigrew et al. (Pub. No. U.S. 2004/0141385).

Morishima discloses all the basic limitations of the claimed invention including extracting information to be written onto the label face from data received from the host computer, but except for formatting the information to fit within a predetermined curved area.

Pettigrew et al. discloses an optical disc labeling system and method, wherein the received label data of high resolution is formatted according to a pixel resolution to fit into the number of available tracks such that the marking can be performed within the label area of the optical disc (paragraphs [0003], [0039]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the process of formatting the input label

data to fit the label area in the device of Morishima as taught by Pettigrew et al. The motivation for doing so would have been to allow high-resolution label data to fit to any remaining restricted area on the label face.

Allowable Subject Matter

7. Claims 17 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter: the primary reason for the indication of the allowability of claims 17 and 22 is the inclusion therein, in combination as currently claimed, of the limitations regarding the different formatting processes of the information data to obtain the information curved to fit within the least number of tracks and successive lines of the information to start within a same track, and the options being presented to the end user for selection. The combined limitations are not found taught by the prior art of record considered alone or in combination.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**HAI PHAM
PRIMARY EXAMINER**

May 27, 2005